

REMARKS

This application has been carefully reconsidered in view of the Office Action of May 11, 2004. It is noted that the Office Action, while acknowledging the presence of claims 22-40, treats only claims 22-31 in the rejection based upon the combination of Peiffer et al. in view of Shiga et al. in view of Reid, and further in view of McAlpin et al. This response will address the rejection based upon the combination of these four references. However, while claims 32-40 are not treated in the Office Action, applicants will further point out the patentability of these claims, as well as the patentability of claims 22-31.

The rejection of claims 22-33 under 35 U.S.C. §103 as obvious in view of Peiffer in view of Shiga in view of Reid, and further in view of McAlpin, is respectfully traversed. In summary of applicants' position as discussed in detail below, applicants would respectfully submit that the combination of the four references does not establish obviousness of applicants' invention as set forth in the claims because: (1) the combination of the four references would not result in a process involving the formation of a film layer of a multi-layer film through the provision of an isotactic propylene-ethylene copolymer with a processing modifier selected from the group of a resin and a rosin in an amount within the range of 1-30 wt.% as specified in claim 1; and (2) the proposed combination of Peiffer, Shiga, Reid and McAlpin involves a hindsight reconstruction of prior art teachings, which becomes possible only after a consideration of applicants' disclosure.

Considering initially point (1) as outlined above, it is noted that the primary reference, Peiffer, fails to disclose an isotactic propylene-ethylene copolymer containing no more than 1 wt.% ethylene in the isotactic polymer structure and further fails to disclose the addition of a processing modifier as called for in applicants' claims. To the extent the Examiner may take the position that the amorphous polymer disclosed in Peiffer might be expected to function as a

processing modifier as required in applicants' claims, it is respectfully submitted that such construction of the Peiffer reference is directly contrary to its teachings. In Peiffer, the amorphous polymer is incorporated into the polyolefin in the form of granules, which forms particulate cavities or "voids" in order to produce a "voided" layer. Moreover, the "voided" layer in Peiffer is preferably in the form of an interlayer in a multi-layer film. Thus the voided layer, even if it were to contain a processing modifier, would not have an exposed surface in which the processing modifier is operative, as required in applicants' invention.

As pointed out above and as acknowledged by the Examiner, the primary reference, Peiffer, does not disclose an isotactic propylene-ethylene copolymer having an ethylene content of up to 1 % by weight as called for in applicants' claims. The propylene-ethylene copolymer disclosed in Shiga is not disclosed to be an isotactic polymer, and the copolymer in Shiga would not appear to be useful in the "void" layer of Peiffer. Thus, it is clear that the only basis for combining the teachings of the prior art references lies in applicants' disclosure, and not in the references themselves.

For the reasons advanced above, it is respectfully submitted that the proposed combination of Peiffer and Shiga cannot be made in a manner to arrive at applicants' invention as set forth in the claims (involving the incorporation of a processing modifier in an isotactic propylene-ethylene copolymer) even if it were proper to use applicants' disclosure as a basis for combining the diverse teachings of the references. However, assuming for the sake of argument that Peiffer and Shiga could be selectively combined in a manner to arrive at applicants' invention, it is believed clear that this cannot be done in a manner consistent with the proper standard to be applied in combining prior art teachings. This standard forbids using an applicants' own disclosure as a basis for assembling prior art teachings and requires a suggestion or motivation in the prior art as reflected in the decisions in *ACS Hospital Systems, Inc. v.*

Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984) and *Ex parte Giles* 228 USPQ 886 (PTO Bd. Of Appeal. And Int. 1985). As expressed by the Board in *Giles* at 688:

Only appellant's disclosure and not the prior art provides a motive for achieving the combination as claimed by the appellant. To imbue one of ordinary skill in the art with knowledge of the invention...when no prior art reference or references of record convey or suggests that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Attention is also respectfully invited to the Federal Circuit decision in *In re Fine*, 5 USPQ 2d 1956 (Fed. Cir. 1988) wherein the Court stated at 1600:

It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made...to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. (Emphasis added)

The standards to be applied in establishing a *prima facie* case of obviousness are emphasized in the Manual of Patent Examining Procedure. As set forth in MPEP §2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not on applicant's disclosure.

The admonitions in *Ex parte Giles* and *In re Fine* are to step back in time to evaluate the invention only in the context of what is disclosed in the references without regard to what is disclosed in applicants' specification. When this is done, it is believed clear that one of ordinary

skill in the art would not arrive at applicants' invention based only upon the references and "the then-accepted wisdom in the art." The patent to Peiffer, as noted above, does not involve the use of a processing modifier of any type in an isotactic propylene-ethylene copolymer having a ethylene concentration of no more than 1.0 wt.% in the isotactic polymer structure. The patent to Shiga, while disclosing a propylene-ethylene copolymer with an ethylene content of 0.1-1 wt.%, does not call for such copolymer to have ethylene in an isotactic polymer structure as recited in applicants' claims. In fact in Shiga the polymers disclosed there are not described as being isotactic. Moreover, while the purpose of the polymer in Peiffer is to form a highly opaque film through the use of a "void" layer, there is nothing in Shiga to suggest that the copolymer used there could be used to form such a void layer. Thus, it is clear that the prior art references provide no suggestion or motivation to attempt to combine the prior art teachings to arrive at applicants' invention.

With respect to the patents to Reid and McAlpin, it is unclear how these additional references enter into the proposed combination of prior art teachings in the attempt to establish obviousness of applicant's invention. It maybe that the Examiner intends Reid to be combined with Peiffer and Shiga in order to address the additional limitation in claims 31 and 39 directed to metallizing the surface of the film layer and McAlpin to be combined with Peiffer and Shiga in an attempt to establish obviousness of claim 26 directed to copolymerization of propylene-ethylene in the presence of a metallocene catalyst. However, be as it may, the incorporation of these additional references into the combination Peiffer and Shiga does nothing to cure the hindsight reconstruction of prior art teachings as addressed above.

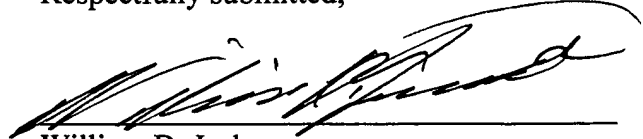
In regard to the processing modifier concentration of 1-30 wt.% as called for in claims 22 and 33, 5-10 wt.% as called for in claims 23 and 34, or about 10% is called for in claims 24 and 35, it is believed clear that the combination of prior art teachings would not produce these

concentration values in the film layer of a multi-layer film. To the extent the Examiner relies upon the paragraph bridging columns 4 and 5 of Peiffer in an attempt to establish obviousness of these concentrations values, it is noted that this portion of the Peiffer reference is directed to the void layer, which in the case of a multi-layer film is called for an applicant's claims, would be an interior layer. Where a multi-layer film as required in applicants' invention is involved in Peiffer, the amorphous polymer in Peiffer is used in a concentration of typically more than 40 wt. %. In this is attention is regard invited to column 3, lines 44-55 of Peiffer. Thus is seems clear that 1 to 30 wt.% figure in Peiffer is applicable to the voided layer as used for the inner layer of a multi-layer film or as used in a single layer embodiment. Where a multilayer film is involved in Peiffer and an amorphous polymer is employed in the film layer of the multi-layer film, the polymer concentration should be more than 40 wt.%. Thus, to attempt to modify the Peiffer reference when combined with the other references to arrive at a film layer of a multi-layer film containing a processing modifier within the range of 1-30 wt.% as called for in applicants' claims would be directly contrary to the teachings of the prior art. With respect, claim 32 which calls for the multi-layer film to be capable of being stretched nine times its original length in the machine direction in combination with being stretched in the transverses direction at a temperature of about 166°C or less, it is noted that Peiffer in column 3, lines 32-44, calls for stretching in the longitudinal direction to be 4: 1 to 7:1, well below the value specified in the applicants' claim 32.

For the reasons advanced above, it is respectfully submitted that all the claims herein are patentable over the prior art. Accordingly an early reconsideration and allowance of this application is respectfully requested.

The Commissioner is authorized to charge any fee due in connection with the submission of this document to the Locke Liddell & Sapp LLP deposit account no. 12-1781.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William D. Jackson', written over a horizontal line.

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